

REMARKS

Claims 1, 27, 28, 30 and 49 have been amended by incorporating the subject matter of claims 4, 10 and 16 into them. Accordingly, claims 4, 10 and 16 have been canceled.

Claims 1-9, 11-15 and 17-49 are currently pending.

The Office Action rejected claims 1-49 under 35 U.S.C. § 103 as obvious over U.S. patent 5,948,394 ("Walling") in view of U.S. patent 5,093,043 ("Jakobson") and further in view of U.S. patent 5,093,043 ("Arnaud"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The claimed invention requires the presence of a specified non-volatile hydrocarbon oil having specified solubility characteristics, a non-volatile silicone oil and a volatile hydrocarbon oil which is incompatible with the silicone oil. Also, the claimed invention requires the presence of specified amounts of silicone oil and/or specific ratios of silicone oil to hydrocarbon oil. This unique combination of ingredients having the specified properties and relationships results in novel glossy, transfer-resistant products. The cited art neither teaches nor suggests such products.

Walling states that his "invention" results from combining "routine materials" in specific amounts. (Col. 1, lines 51-57). Thus, the question raised by the pending rejection is whether the specific amounts disclosed by Walling would lead one skilled in the art to the presently claimed invention. The answer is "no."

As recognized by the Office Action, Walling fails to expressly teach "the particular percentages of each ingredient." (Office Action at page 3). Thus, only Walling's examples

provide the specific amounts required to reproduce Walling's invention. However, these examples do not contain any liquid, non-volatile silicone compound. Thus, these examples cannot teach or suggest compositions in which (a) said non-volatile silicone compound is present in an amount ranging from 1% to 85% by mass, based on the total mass of the composition; (b) a ratio by mass of said non-volatile silicone compound relative to said non-volatile hydrocarbon-based oil is greater than or equal to 1; or (c) both.

Moreover, given that Walling stated that his "invention" results from combining "routine materials" in specific amounts, one skilled in the art would not have been motivated to modify Walling's compositions to include (a) a non-volatile silicone compound present in an amount ranging from 1% to 85% by mass; (b) a ratio by mass of non-volatile silicone compound relative to non-volatile hydrocarbon-based oil greater than or equal to 1; or (c) both. In fact, Walling's disclosure actually teaches away from such a modification --- to achieve Walling's results, Walling teaches that his specific disclosure must be followed.

Walling completely fails to teach, suggest or recognize the importance of combining compounds having all of the specified properties and relationships required in the claims: that is, Walling could not possibly lead one skilled in the art to combine a hydrocarbon-based oil **and** a non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other in the required amounts/ratios. Walling contains no guidance whatsoever to make such a unique combination.

It would not merely have been a matter of “optimization” of Walling’s disclosure to choose all of the required ingredients, properties and relationships in the invention compositions from Walling’s general disclosure to arrive at the claimed invention. Following Walling’s disclosure does not allow for optimization. Rather, to achieve Walling’s results, Walling’s disclosure must be followed, and the specific amounts of the “routine” ingredients must be added.

Clearly, Walling neither teaches nor suggests the claimed invention, and one skilled in the art following Walling’s disclosure would not be led to the present invention.

Jakobson and Arnaud do not compensate for Walling’s deficiencies. Jakobson is cited only for its disclosure related to diglyceryl diisostearate, and Arnaud is not cited for any reason. Neither reference teaches, suggests, or recognizes the importance of combining a hydrocarbon-based oil and a non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other in the claimed amounts/ratios.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection.

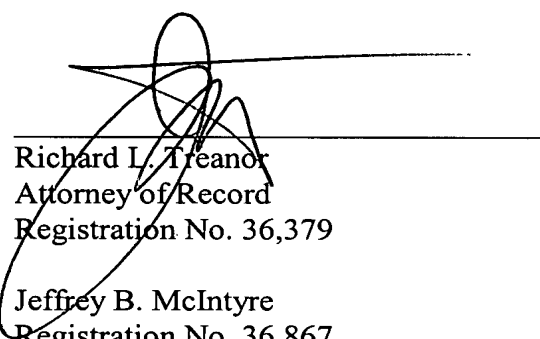
Application No. 09/728,056
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Applicant believes that the present application is in condition for allowance.

Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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